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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 08/719,639 | 09/25/96 | MATTAWAY | S N0003/7013 |

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EXAMINER

CARMAN, M

ART UNIT

PAPER NUMBER

2733

DATE MAILED:

02/03/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/719,639

Applicant(s)

Mattaway et al.

Examiner
Melissa Kay Carman *mpc*

Group Art Unit
2733



☒ Responsive to communication(s) filed on Sep 25, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Claim Objections

1. Claims 3 and 14 are objected to because of the following informalities:

- a) in claim 3, line 2, delete "selected of a", and insert therefore --a selected--;
- b) in claim 14, lines 3 and 4, delete "selected of a", and insert therefore --a selected--.

Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 11 and 22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "the notification signal", does not reasonably provide enablement for "a haptic sensor signal". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and or use the invention commensurate in scope with these claims.

Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Oberlander et al** (US 5,825,865). Please see figures 1 and 5; col. 3, lines 49-67; col. 5, lines 16-24; and col. 8, lines 15-50.

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103[®] and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2-10 and 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Oberlander** (US 5,825,865) as applied to claims 1 and 12 above, and further in view of **Blonder et al** (US 5,708,422).

Consider claims 2-8 and 13-19, **Oberlander** teaches message routing in a communication network that supports and responds to an information profile, as shown above. **Oberlander** does not teach the generation of a notification signal, nor its association with an information profile. **Blonder** teaches a method and apparatus for using a communications system to alert a transaction user. The system for alerting the user includes a database, for receiving information and storing a profile; a processor, for retrieving the profile from the database and comparing information associated with the profile; and a network, over which a notification signal is transmitted (Fig 1, col. 5, lines 33-47; col. 7, lines 21-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of **Oberlander** to include the notification signal found in the teachings of **Blonder** because of the advantage that it allows the system to be equipped with a means for notifying the user and accommodates a wide variety of communication platforms and allows the user to better control reception of their incoming messages to best suit their own particular needs (see **Oberlander**, col. 2, lines 11-16).

Consider claims 9, 10, 20, and 21, **Blonder** fails to teach a notification signal as being an audio signal or a graphic image signal. The examiner takes Official Notice that both the concept and the advantage of providing a notification signal which includes an audio signal or a graphic image signal are well known and expected in the art. It would have been obvious to include an audio signal or a graphic image signal to **Blonder** as both the audio and the graphic image signal are known to provide the user with both auditory and visual feedback to the communication system.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Miller et al (US 5,475,819) teaches methods of providing configuration profiles to users in a distributed computing system.

Eikeland (US 5,828,837) teaches a computer network for providing directed information to users based upon the user profile.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Melissa Kay Carman whose telephone number is 703/308-7605. The examiner can normally be reached on Monday-Friday from 7:00AM - 3:30PM, Eastern Time.

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If attempts to reach the examiner by telephone are not successful, the examiner's supervisor, Mr. Jason Chan, can be reached on 703/305-4729.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

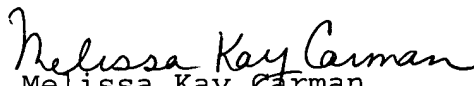
(703) 308-9051, for formal communications intended for entry


Or

(703) 308-5403, for informal or draft communications,
please label "PROPOSED" or "DRAFT".

Hand-delivered responses should be brought to
Crystal Park II, 2121 Crystal Drive, Arlington, Virginia,
Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is 703/305-3900.


Melissa Kay Carman
Patent Examiner


Jason Chan
Supervisory Patent Examiner
Technology Center 2700